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REMARKS/ARGUMENTS

Claims 1-22 were pending, examined, and rejected. The Examiner objected to an informality in Claim 16, rejected claims 1-22 under 35 U.S.C. § 101 as being directed to nonstatutory subject matter, rejected claims 2, 9, and 17 under 35 U.S.C. § 112, first paragraph as failing to comply with the written description requirement, rejected claims 1, 2, 8, and 9 under 35 U.S.C. § 102(e) as being unpatentable over Knight (U.S. Patent No. 7,043,619), hereinafter "Knight," and rejected claims 3-7 and 10-22 over Knight in view of Whiting (U.S. Patent No. 5,778,395).[1]

Objection to Claim 16

Applicant has amended Claim 16 as suggested to address the objection. Applicant thanks the Examiner for identifying the objection and respectfully requests the Examiner to withdraw the objection.

Claim rejections under 35 U.S.C. § 101

The Examiner rejected Claims 1-22 under 35 U.S.C. § 101 as being directed to nonstatutory subject matter. Applicant has amended the independent Claims 1, 8, 15, and 16 to recite, for example, performing a backup operation to backup at least one file. Applicant submits that the amended claims are directed to statutory subject matter and Applicant respectfully requests the Examiner to reconsider and withdraw the rejection.

Claim rejections under 35 U.S.C. § 112, first paragraph

The Examiner rejected Claims 2, 9, and 17 under Section 112, first paragraph for failing to comply with the written description requirement. Applicant has amended Claims 2, 9, and 17 to delete the references to receiving redundant copies of backup data. Applicant believes

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[1] The summary of the rejection under Section 103(a) on Page 6 of the Office Action states that the rejected claims are 3-7 and 14-22. It is apparent, however, that the Examiner actually reject Claims 3-7 and 10-22 and Applicant responds to the rejection accordingly.

that Claims 2, 9, and 17 as amended are fully compliant with the requirements of Section 112, first paragraph and Applicant respectfully requests the Examiner to reconsider and withdraw the rejection.

Claim rejections under 35 USC § 102(e)

The Examiner rejected claims 1, 2, 8, and 9 under 35 U.S.C. § 102(e) as being anticipated by Knight.

With respect to independent Claim 1, Applicant respectfully traverses the rejection because the cited reference does not teach expressly or inherently all of the claim elements.

Claim 1 recites, for example, installing a daemon application on systems with available disk space to store backup files and receiving [first] metadata from the installed daemon applications, where the metadata includes information regarding available disk space.

The Examiner indicates on Page 5 of the Office Action that Knight teaches a Storage Configurator Software Program (the Configurator) that is analogous to the recited daemon application and that Knight teaches Storage Area Networks (SANs) 116 that are analogous to the recited systems with available disk space. Assuming solely for the sake of this discussion that Knight's Configurator is analogous to the recited daemon application and that Knight's SANs 116 are analogous to the recited systems with available disk space, Knight still fails to anticipate Claim 1. Whereas Claim 1 unambiguously recites that the systems that have available disk space are the same systems on which the daemon application is installed, Knight unambiguously distinguishes between the computer systems on which its Configurator is installed and its SANs 116. Knight clearly describes that Configurator is installed either on a client computer system 102 or one of the various server computers. See, e.g., Knight at Column 4, lines 21-30. Knight also clearly distinguishes SANs 116, which Knight refers to as a "storage device," from the systems that Knight refers to as computer systems. See, e.g., Knight a Column 3, lines 46-55. Thus, it is clear that Knight's Configurator is not installed on Knight's SAN 116 and, therefore, Knight cannot anticipate a claim, such as Claim 1, that recites installing a daemon application on a system with available disk space.

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In addition, Claim 1 recites receiving a request from a backup application to download a master file. Claim 1 further recites that the master file includes information regarding a list of systems available to store backup files and an amount of available disk space to store backup files. The Examiner indicates that Knight teaches receiving a request from a backup application to download the master file at Column 10, lines 7-25. Applicant respectfully disagrees with the Examiner's construction of the claim elements to encompass Knight's teaching.

The cited portion of Knight describes steps 306 and 308 of Knight's FIG. 4. Step 306 is about determining an optimal storage layout and Step 308 is about displaying the optimal storage layout to a user. See Knight, FIG 4. Nowhere in the cited portion of Knight of FIG 4 is there any express or inherent teaching of receiving a request from a backup application to download a master file that contains information on systems available for storing backup files. In addition, the Examiner analogizes the recited backup application to Knight's Edition Extension Backup Application 160. Thus, the anticipation rejection would be proper only if Knight included some express or inherent teaching of its EE Backup Application 160 requesting to download a master file having information about the available systems and the storage capacity of the available systems. Far from teaching anything even remotely resembling the request for the master file as claimed, Knight refers to EE Backup Application 160 only once, in the passage that describes it only as an application for backing up "the application's data." Setting aside the ambiguity of Knight's description of EE Backup Application 160, there is certainly nothing in Column 10 lines 7-25 of Knight, nor anywhere else in Knight, teaching Knight's EE Backup Application 160 requesting a master file.

Because the cited reference does not teach either expressly or inherently all of the claim elements, Applicant submits that the cited reference does anticipate Claim 1. Accordingly, Applicant respectfully requests the Examiner to reconsider and withdraw the anticipation rejection of Claim 1. Analogous remarks apply to Claim 2, Claim 8, and Claim 9, which were also rejected as being anticipated by Knight.

Claim rejections under 35 U.S.C. § 103(a)

Claims 3-7 and 10-22 were rejected under Section 103(a) as being unpatentable over Knight in view of Whiting.

With respect to the rejections of claims 3-7 and 10-14, Applicant traverses the rejection because the cited references do not teach or suggest all of the claim elements. A Section 103(a) rejection is improper unless the cited references teach or suggest all claim limitations. MPEP 2143.03.

Claims 3-7 depend on Claim 1. The Section 103(a) rejection of claims 3-7 is expressly based on the Section 102(e) rejection of Claim 1 with respect to all of the Claim 1 elements. For reasons analogous to the reasons stated above with respect to Claim 1, Knight does not teach or suggest all of the elements of Claims 3-7 and Whiting is cited only for its alleged teaching of compressing and encrypting files. Accordingly, because the cited references do not teach or suggest all of the elements of Claims 3-7, Applicant respectfully requests the Examiner to reconsider and withdraw the rejections.

Claims 10-14 depend on Claim 8. The Section 103(a) rejection of claims 10-14 is expressly based on the Section 102(e) rejection of Claim 8 with respect to all of the Claim 8 elements. For reasons analogous to the reasons stated above with respect to Claim 1 and Claim 8 by analogy, Knight does not teach or suggest all of the elements of Claims 10-14 and Whiting is cited only for its alleged teaching of compressing and encrypting files. Accordingly, because the cited references do not teach or suggest all of the elements of Claims 10-14, Applicant respectfully requests the Examiner to reconsider and withdraw the rejections.
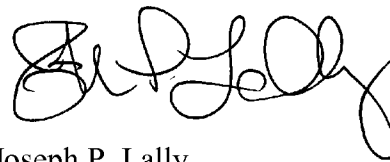
With respect to Claim 15, Applicant traverse the Section 103(a) element because the cited references do not teach or suggest all of the claim elements. Applicant submits that the remarks submitted above with respect to the anticipation rejection of Claim 1 are applicable by analogy to the Section 103(a) rejection of Claim 15 because Claim 15 recites elements analogous to the elements of Claim 1 and the Claim 15 rejection relies on the same support as did the Claim 1 rejection. Accordingly, because the cited references do not teach or suggest all of the claim elements, Applicant respectfully requests the Examiner to reconsider and withdraw the Section 103(a) rejection of Claim 15.

With respect to Claim 16, Applicant traverse the Section 103(a) element because the cited references do not teach or suggest all of the claim elements. Applicant submits that the remarks submitted above with respect to the anticipation rejection of Claim 1 are applicable by analogy to the Section 103(a) rejection of Claim 16 because the Claim 16 rejection relies on the substantially the same support as did the Claim 1 rejection. Although the rejection of Claim 16 makes specific reference to Knight's Discoverer 212, Discoverer 212 is a component of Knight's Configurator, which was discussed above with respect to Claim 1. Accordingly, because the cited references do not teach or suggest all of the claim elements, Applicant respectfully requests the Examiner to reconsider and withdraw the Section 103(a) rejection of Claim 16.

CONCLUSION

The paper contains a reply to each ground of objection and rejection set forth in the Office Action. Applicant respectfully requests reconsideration and favorable action on all pending claims. If the Examiner has any questions, comments, or suggestions, the undersigned attorney would welcome and encourage a telephone conference at 512.236.2019.

Respectfully submitted,
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